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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,768	12/29/2000	Henri Waelbroeck	061165-0007	8654
9629	7590	12/17/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			HAMILTON, LALITA M	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/750,768

Applicant(s)

WAELEBROECK ET AL.

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12122004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-24 and 31-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Shaw (US 2003/0004859).

Shaw discloses a method for facilitating secure transactions comprising electronically receiving data including confidential information regarding market Participants, electronically receiving an order and targeting parameters from a first market participant, identifying a second market participant that is most likely to take a contra side of said order, wherein said step of identifying is based, at least in part, on said received confidential information regarding market participants, and routing said order to said identified second market participant (p.4, 50 and p.9, 162 to p.10, 177); producing a targeted dissemination list of market participants based, at least in part, on said received confidential information regarding market participants and said order and targeting parameters, and wherein the step of identifying a second market participant that is most likely to take a contra side of said order is based on said dissemination list (p.5, 71-79; p.6-7, 101; and p.7, 122 to p.8, 142); the confidential information comprises

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trading interest information (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 177); the confidential information comprises certified trading interest information (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 177); the confidential information comprises a time of a call (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said second market participant is based on order size (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said second market participant is based on execution size (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said second market participant is based on price aggression (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said second market participant is based on location (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said market participant is based on comparing the past behavior of market participants after they received notifications or orders (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said market participant is based on time of auction call (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said market participant is based on comparing the past behavior of market participants after they received orders (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); identifying said second market participant is based on time of most recent execution (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); producing a targeted dissemination list of market participants based on said stored data regarding market participants and said order and targeting parameters is

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based on relations between said stored data not known to said first market participant (p.2, 27); relations comprise information indicating that multiple data entries involve a same end party (p.2, 27); producing said targeted dissemination list comprises calculating the total number of shares bought or sold by said end party (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); producing a targeted dissemination list of market participants based on said stored data regarding market participants and said order and targeting parameters is based on data that is not available to any individual market participant, and wherein said step of producing a targeted dissemination list comprises aggregating data provided by a plurality of market participants (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); producing a targeted dissemination list of market participants based on said stored data regarding market participants and said order and targeting parameters is based on data that is not available to any individual market participant, and wherein said step of producing a targeted dissemination list comprises comparing data provided by a plurality of market participants (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); aggregating data is based on data that is provided by a marketplace (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); data that is provided by a marketplace is Automated Continuation Transaction Service data and said marketplace is the Nasdaq Stock Markets (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175---data may come from any source and may be any marketplace); aggregating data is based on data that is

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provided by a plurality of participating broker-dealers (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); comparing data provided by a plurality of market participants comprises the step of netting out middlemen to identify an end buyer and an end seller in a trade (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); aggregating data is based on data that comprises the identity of a buy-side party for which a trade was executed (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); comparing data provided by a plurality of market participants comprises the step of calculating the total number of shares bought or sold by a buy-side party for which a trade was executed through one or more intermediaries (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); probability of execution is calculated based on a count of number of orders delivered versus number of executions for different types of orders (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); electronically reporting an estimate of the price impact following the delivery of an order based on said query to said first market participant (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); electronically receiving data comprising order status information from said second market participant (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); reporting order execution to said first market participant if said order status information indicates that said order received from said first market participant was executed (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); removing the designation of being reserved from an order if said order status information indicates that the order was released by said

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second market participant (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175); and one or more call auction event times, electronically storing said received data regarding said first market participant, electronically receiving an order from a second market participant, routing said Order to said first market participant at a time within a configurable time window surrounding one of said one or more call auction event times (p.4, 50; p.5, 71-79; p.6-7, 101; p.7, 122 to p.8, 142; p.9, 162 to p.10, 170-175).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw in view of Lupien (5,950,177).

Shaw discloses the invention substantially as claimed; however, Shaw does not disclose ranking market participants on said targeted dissemination list in order of

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likelihood of taking the contra side of said order and if said identified second market participant does not execute said order, successively routing said order to the remaining market participants on said ranked targeted dissemination list, in order of likelihood of taking the contra side of said order, until said order is executed; ranking is based on probability of execution; or probability of execution is calculated based on a count of number of orders delivered versus number of executions for different types of orders. Lupien teaches a method for matching orders comprising ranking market participants on said targeted dissemination list in order of likelihood of taking the contra side of said order and if said identified second market participant does not execute said order, successively routing said order to the remaining market participants on said ranked targeted dissemination list, in order of likelihood of taking the contra side of said order, until said order is executed (col.3, line 49 to col.4, line 51); ranking is based on probability of execution (col.3, line 49 to col.4, line 51); and probability of execution is calculated based on a count of number of orders delivered versus number of executions for different types of orders (col.3, line 49 to col.4, line 41). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate ranking market participants on said targeted dissemination list in order of likelihood of taking the contra side of said order and if said identified second market participant does not execute said order, successively routing said order to the remaining market participants on said ranked targeted dissemination list, in order of likelihood of taking the contra side of said order, until said order is executed; ranking is based on probability of execution; and probability of execution is calculated based on a count of number of

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orders delivered versus number of executions for different types of orders, as taught by Lupien into the invention disclosed by Shaw, to demonstrate an alternative way of matching the orders successfully.

Provisional Application Listed on PTO-892 form

If a copy of a provisional application listed on the bottom portion of the accompanying Notice of References Cited (PTO-892) form is not included with this Office action and the PTO-892 has been annotated to indicate that the copy was not readily available, it is because the copy could not be readily obtained when the Office action was mailed. Should applicant desire a copy of such a provisional application, applicant should promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1). If a copy is ordered from OPR, the shortened statutory period for reply to this Office action will not be reset under MPEP § 710.06 unless applicant can demonstrate a substantial delay by the Office in fulfilling the order for the copy of the provisional application. Where the applicant has been notified on the PTO-892 that a copy of the provisional application is not readily available, the provision of MPEP § 707.05(a) that a copy of the cited reference will be automatically furnished without charge does not apply.

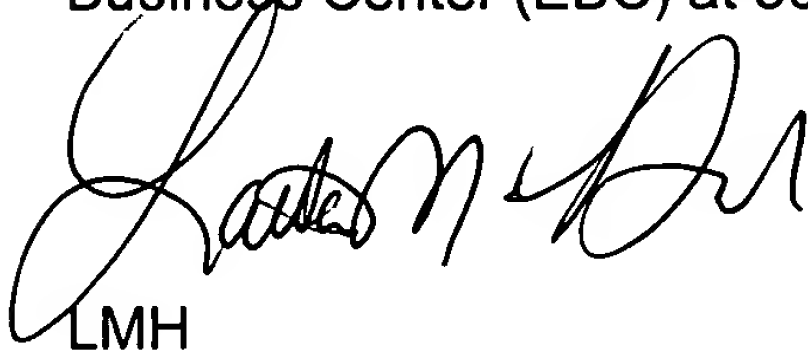
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LMH